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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,841	12/22/2005	Yukio Miyairi	126400	3189

27049 7590 12/09/2009

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EXAMINER	
MAYEKAR, KISHOR	
ART UNIT	PAPER NUMBER
1795	

NOTIFICATION DATE	DELIVERY MODE
12/09/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction27049@oliff.com
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Office Action Summary	Application No.	Applicant(s)	
	10/561,841	MIYAIRI ET AL.	
	Examiner	Art Unit	
	Kishor Mayekar	1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 July 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment of 28 July 2009 has been entered. Claims 1, 2 and 10 have been amended and new claims 11-13 have been introduced. Claims 1-13 are pending in this application with claim 1 being sole independent claim.

2. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 13, the recited "a length … per unit are" is confusing as to what unit area is based upon.

In claim 13, the recited "an area … per unit are" is confusing as to what unit area is based upon.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1 and 5-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/560,805 in view of Li et al. (US 6,979,892 B2). The patent claim 1 claim a plasma generating electrode comprising at least a pair of unit electrodes having a plate-shaped ceramic body as a dielectric and conductive film disposed inside the ceramic

body, wherein a plurality of conductive film through-holes are formed on the conductive film. The differences between the patent claim 1 and claim 1 of the present invention are the provision of the recited plurality of protrusions. Li, a reference cited in the last Office action, teaches the limitation in a plasma generating electrode and the limitation of the above dependent claims (Fig. 26; and c. 10, l. 57-62). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the patent claim as shown by Lin because the provision would result in strengthen the unit electrodes.

This is a provisional obviousness-type double patenting rejection.

As to the subject matter of claim 5, Li teaches it in Fig. 5.

As to the subject matter of claim 11, patent claim has the range.

As to the subject matter of claims 12 and 13, the selection of the recited length and the recited area would have been within the level of ordinary skill in the art.

7. Claims 2-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/560,805 in view of Li '892, and further in view of Nelson et al. (US 6,821,493 B2). The further differences are the subject matter in each of the instant claims. Nelson, another reference cited in the last Office action, teaches the limitations in a plasma generating electrode (Figs. 6-8). The subject matter as a whole would have been obvious

to one having ordinary skill in the art at the time the invention was made to have modified the patent claim as modified by Lin and as shown by Nelson because the selection of any of known equivalent methods of preparing a multi-cell plasma generating electrode would have been within the level of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection.

8. Claims 1 and 5-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/560,858 in view of Li '892. The patent claim 1 claim a plasma generating electrode comprising at least a pair of unit electrodes having a plate-shaped ceramic body as a dielectric and conductive film disposed inside the ceramic body, wherein a plurality of conductive film through-holes are formed on the conductive film. The differences between the patent claim 1 and claim 1 of the present invention are the provision of the recited plurality of protrusions. Li teaches the limitation in a plasma generating electrode (Fig. 26; Fig. 5; and c. 10, l. 57-62). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the patent claim as shown by Lin because the provision would result in strengthen the unit electrodes.

This is a provisional obviousness-type double patenting rejection.

As to the subject matter of claim 5, Li teaches it in Fig. 5.

9. Claims 2-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/560,805 in view of Li '892, and further in view of Nelson '493. The further differences are the subject matter in each of the instant claims. Nelson teaches the limitations in a plasma generating electrode (Figs. 6-8). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the patent claim as modified by Lin and as shown by Nelson because the selection of any of known equivalent methods of preparing a multi-cell plasma generating electrode would have been within the level of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection.

Conclusion

10. Claims 1-13 are rejected.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kishor Mayekar/
Primary Examiner, Art Unit 1795